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09/750,001	12/29/2000	Scott M. Frank	190252-1220	6605

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EXAMINER	
OUELLETTE, JONATHAN P	
ART UNIT	PAPER NUMBER
3629	

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01/27/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/750,001	FRANK ET AL.	
	Examiner	Art Unit	
	Jonathan Ouellette	3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 November 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *86-103* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *86-103* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. Claims 1-85 and 104-109 have been cancelled; therefore Claims 86-103 are currently pending in application 09/750,001.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 86, 92, and 98 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

4. Independent Claims 86, 92, and 98 disclose receiving disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, wherein the disclosure gift information includes information regarding disclosure gifts purchased by the organization *from outside the organization* and stocked by the organization for being given to the plurality of innovators for the organization; responsive to receiving the disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, and automatically updating an associated balance of stocked disclosure gifts.

5. While the specification and original claims do support providing innovators with gifts for submissions, determining the specific gift based on the innovation, tracking gift balance information, and tracking gift costs and suppliers; neither the specification nor the original claims support wherein the gifts are purchased from ***outside*** the organization. (supplier could indicate internal source).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 86-103 are rejected under 35 U.S.C. 103 as being unpatentable over Hunter (US 6,298,327) in view of Eggleston et al. (US 6,061,660).

9. As per **independent Claims 86, 92, and 98**, Hunter discloses a computer-readable medium containing a program for use with a computer (apparatus, method) for tracking innovations as part of a system for managing protection and licensing of intellectual property assets (abstract, Fig.2, Fig.8), the program comprising: receiving intellectual property asset protection data (inventive disclosure, C2-C5), wherein the intellectual property asset protection data includes protection data corresponding to a plurality of intellectual property assets owned by the organization, wherein each intellectual property asset is defined and maintained as an asset by the existence of legally-enforceable intellectual property protection

rights pertaining to that intellectual property asset (C8 L1-11, inventive disclosure, inventive identity, established date of invention or conception), wherein the intellectual property asset protection data further includes data related to a plurality of innovation disclosures, each innovation disclosure associated with one of a plurality of innovators for the organization (system tracks multiple inventions from multiple inventors); determining participation data for each of a plurality of innovator classes (C3 L53-67, invention categorized with specific technology group); and storing the intellectual property asset protection data in an intellectual property asset protection database including a plurality of intellectual property asset protection data records (C2-C5, Fig.2, database).

10. While Hunter does disclose tracking innovations, inventors, and inventor related information (C11 L48-57, C18 Table 3), Hunter fails to expressly disclose receiving disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, wherein the disclosure gift information includes information regarding disclosure gifts purchased by the organization from outside the organization and stocked by the organization for being given to the plurality of innovators for the organization; responsive to receiving the disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, and automatically updating an associated balance of stocked disclosure gifts.

11. However, Eggleston discloses the creation of employee incentive programs, which include tracking/automated fulfillment of non-monetary reward distribution data to include sponsor and award databases (Fig.20, C8 L13-20, C31 L25-67, C32 L1-20, C45-C46). Furthermore, Eggleston discloses utilizing an awards tracking database and inventory replenishment

technology (C39-40). *Finally, Eggleston discloses Merchandise as a prize type, which would have inherently been purchased from an outside source since Eggleston dos not disclose using the system for a merchandise manufacturing company (Also – See 112 rejection above).*

12. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included receiving disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, wherein the disclosure gift information includes information regarding disclosure gifts purchased by the organization from outside the organization and stocked by the organization for being given to the plurality of innovators for the organization; responsive to receiving the disclosure gift information associated with each innovation disclosure of the plurality of innovation disclosures, and automatically updating an associated balance of stocked disclosure gifts, as disclosed by Eggleston in the system disclosed by Hunter, for the advantage of providing a method for tracking innovations with the ability to increase effectiveness of the system by offering/tracking all facets of innovations submission process, to include compensating/awarding the innovation submitter. (See KSR [127 S Ct. at 1739] "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.").
13. As per Claims 87, 93, and 99, Hunter discloses tracking and reporting costs associated with the purchase of disclosure gifts (C45-C46, sponsor and award database).

14. As per Claims 88, 94, and 100, Hunter discloses tracking and reporting information arranged by innovator regarding all disclosure gifts sent to each innovator of the plurality of innovators (C45 L27-50, consumer/participant database).

15. As per Claims 89, 95, and 101, Hunter discloses automatically totaling numbers of disclosure gifts distributed within a time period (C45-C46, sponsor and award database information/ aggregation of information based on date).

16. As per Claims 90, 96, and 102, Hunter and Eggleston fail to expressly show wherein the plurality of innovator data, including employee/contractor status and a management /non-management status.

17. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation disclosures by an organization would be performed regardless of the type of innovator data stored. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

18. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a plurality of innovator data, to include: employee/contractor status and a management /non-management status, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

19. As per Claims 91, 97, and 103, while Hunter does disclose storing organization data associated with the innovator (Para0109, type of originator), Hunter fails to expressly show

the organization data related to the innovator and including at least one of affiliate organization, company, division, and business unit.

20. However these differences are only found in the nonfunctional descriptive data and are not functionally involved in the steps recited. The method for tracking innovation disclosures by an organization would be performed regardless of the type of innovator descriptive data used. Thus, this descriptive data will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack,* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).
21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included a innovator descriptive data (organization al date) to include: at least one of affiliate organization, company, division, and business unit, because such data does not functionally relate to the steps in the method claimed and because the subjective interpretation of the data does not patentably distinguish the claimed invention.

Response to Arguments

22. Applicant's arguments filed 11/6/2008 regarding Claims 86-103 have been considered, but are not persuasive. The rejection will remain as FINAL based on the sited prior art.
23. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

24. Regarding the Applicant's arguments, the Applicant is directed to the revised/clarified rejection above.

Conclusion

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan Ouellette whose telephone number is (571) 272-6807. The examiner can normally be reached on Monday through Thursday, 8am - 5:00pm.

26. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone numbers for the organization where this application or proceeding is assigned (703) 872-9306 for all official communications.

27. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-5484.

January 27, 2009
/Jonathan Ouellette/
Primary Examiner, Art Unit 3629